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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,584	05/16/2001	Thomas M. Collins	2280.2700	1405

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EXAMINER

BATURAY, ALICIA

ART UNIT PAPER NUMBER

2155

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/855,584

Applicant(s)

COLLINS ET AL.

Examiner

Alicia Baturay

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☒ Claim(s) 12-23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) *
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 09212004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-29 are pending.

Specification

2. The use of the trademark Outlook has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

3. The disclosure is objected to because of the following informalities: on page 10, line 10 Applicant states "append a attachment." It is believed Applicant meant to write "append an attachment." Appropriate correction is required.

Claim Objections

4. Claims 12-17 are objected to for use of the term "apparatus" in claim 12. This expression is not specific enough to indicate the use of a computer or processor.
5. Claims 18-23 are objected to for use of the term "electronic" in claim 18. This expression is not specific enough to indicate the use of a computer or processor.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-6 recite codes in the body.

Claims 7-11 recite a number of categories, which are essentially data structures *per se*.

Descriptions and expressions of a computer program not encoded on a computer readable medium do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and therefore is considered non-statutory functional descriptive material (See MPEP 2106.IV.B.1(a)). Therefore Claims 1-11 are directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-5, 7-16, 18-22, and 24-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Kohler (U.S. 6,192,396).
10. As to claim 1, Kohler describes an application for transmitting electronic mail from a sender to a plurality of recipients (Kohler, col. 1, lines 7-12) comprising: code enabling the sender to input a message (Kohler, Fig. 6, element 51), code enabling the sender to append an attachment to the message (Kohler, Fig. 6, element 46), code enabling the sender to designate at least one recipient of the plurality of recipients to receive the message and the attachment and code enabling the sender to designate at least one recipient of the plurality of recipients to receive the message without the attachment (Kohler, col. 2, lines 14-21).
11. As to claims 2, 8, 13, 19, and 25, Kohler discloses the invention substantially including that the sender and recipients are computers connected to a network (Kohler, col. 3, lines 51-53).
12. As to claims 3, 9, 14, 20, and 26, Kohler discloses the invention substantially including that the network is the Internet (Kohler, col. 3, line 57-60).
13. As to claim 4, 10, 15, 21 and 27, Kohler discloses the invention substantially including that the network is a local area network (LAN) (Kohler, col. 3, line 57).

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14. As to claims 5, 11, 16, 22, and 28, Kohler discloses the invention substantially including that the network is a wide area network (WAN) (Kohler, col. 3, line 57-58).

15. As to claim 7, Kohler discloses the invention substantially including allowing a sender to designate a recipient as one of the following categories (Kohler, col. 7, lines 17-19): a first category indicating the recipient of the electronic mail is to receive both a text message and an attached file, a second category indicating the recipient of the electronic mail is to receive both a text message and an attached file, and a third category indicating the recipient of the electronic mail is to receive a text message without the attached file (Kohler, col. 7, lines 30-40; Fig. 6, element 63).

16. As to claim 12, claim 1 is a method performing the same functions as claim 12. Therefore, paragraph 10 of this Office Action discloses all of the limitations of claim 12.

17. As to claim 18, claim 1 performs the same functions as claim 18. Therefore, paragraph 10 of this Office Action discloses all of the limitations of claim 18.

18. As to claim 24, claim 1 is a method performing the same functions as claim 24. Therefore, paragraph 10 of this Office Action discloses all of the limitations of claim 24.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 6, 17, 23 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohler as applied to claim 1 above, and further in view of Thurlow, et al (U.S. 5,917,489).

As to claims 6, 17, 23 and 29, Kohler discloses the invention substantially as described in claim 1, but do not explicitly teach recipient creation of a profile. However, Thurlow teaches a similar system for sending email that includes user profiles (Thurlow, col. 7, lines 54-58) including preferences regarding the receipt of attachments (Thurlow, col. 10, lines 55-67; col. 11, Table 1). It would have been obvious to combine the teachings of Kohler and Thurlow to allow for an improved method of creating and editing rules for processing electronic mail (Thurlow, col. 1, lines 55-57).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Baturay whose telephone number is (703) 305-8865. The examiner can normally be reached on 7:15am - 3:45pm, Monday - Friday. The examiner will be moving in mid-October and can be reached then at (571) 272-3981. The Tech Center main telephone number will be (571) 272-2100.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (703) 308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AB


HOSAIN ALAM
SUPERVISORY PATENT EXAMINER